

REMARKS

At the outset, Applicant wishes to clarify the restriction/election history for the instant application. An outline of such history is set forth below:

<u>DATE</u>	<u>ACTION</u>
April 2, 2003	Examiner required restriction between Groups 1-94
April 30, 2003	Applicant elected Group 79 (Claims 204, 205, and 236-253). In traverse to the restriction requirement, Applicant pointed out that Groups 80-84 were believed to be directed to the same invention as Group 79
August 21, 2003	Examiner made further restriction requirement regarding previously-elected Group 79 claims (Claims 204, 205, 236-253)
August 26, 2003	Applicant elected Claims 204, 205, 236-239, and 243-253
November 28, 2003	Examiner acted on merits of the claims of the elected Group 79 invention (Claims 204, 205, 236-239, and 243-253)
February 17, 2004	Applicant responded to November 28, 2003 Office Action by canceling Claims 204, 205, and 237. Claim 237 was incorporated into Claim 236. Canceled claim 237 (now 236) was always part of the elected Group 79 invention that the Examiner had examined on the merits
June 1, 2004	Examiner held the Amendment of February 17, 2004 to be non-responsive.

In the restriction requirement of April 2, 2003, the Examiner defined the Group 79 invention to be drawn to “a method of growing a new portion of a pre-existing organ comprising administering a growth factor to produce muscle.” All of the present claims, i.e., Claims 254, 255, 236, 238, 239, and 243-253, utilize a growth factor to grow muscle in an organ (a heart being an organ specie). Thus, the Examiner is incorrect in stating that the claims do not read on the claims of the elected Group 79 invention.

On the other hand, the Examiner defined Group 83 to be drawn to “a method of growing a new portion of a pre-existing organ comprising administering a growth factor to produce muscle, and further comprising placing a growth factor to grow new arteries thereby reviving a dead portion of the organ.” Please note that present claims 254, 255, 236, 238, 239, and 243-253 do not require revival of a dead portion of an organ. Thus, it is clear that the present claims fall within the Examiner’s prior definition of the elected Group 79 invention, not within the non-elected Group 83 invention as alleged by the Examiner.

Basis for the term “cardiac muscle” included in amended claim 236 and new claim 256 is found at Pages 45 and 46 of the instant specification.

Applicant points out that “cardiac muscle” is different from the new muscle tissue formed from the skeletal myoblasts described by Murry et al. Murry recognizes such difference in the last five (5) lines of the first full paragraph of page 2521 and in Figure 1 of 2515-2516 and its legend discussions of the Murry et al. publication of December 1996.

Clearly, the subject matter of claim 236 and 256 is novel.

In Applicant’s February 17, 2004 Amendment, claims 204 and 205 were canceled. Such claims have been replaced and reinstated by the instant Amendment as Claims 254 and 255. Thus, no change in these claims exists, and Applicant’s prior amendment (of February 17, 2004) cannot be considered to be non-responsive in this regard. In addition, new claim 256 was added. Such claim generally corresponds to claim 236 prior to its amendment. Thus, no shift from the elected invention was made. It is also pointed out that previous claim 237 was examined on the merits as part of the elected Group 79 invention. The mere cancellation of claim 237, along with its combination into independent claim 236, cannot be regarded as non-responsive because amended claim 236 (formerly claim 237) was always present, was deemed by the Examiner to fall within the elected Group 79 invention, and was previously examined with the elected Group

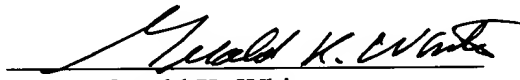
79 invention. Please note that claim 236 required the growth of new muscle, and claim 237, because of its dependency upon claim 236, required the growth of new muscle and a new artery. It is again pointed out that present claim 236 falls within elected Group 79 because such claim requires the growth of new muscle. To consider the above-mentioned incorporation of claim 237 into claim 236 as somehow resulting in a claim falling within the non-elected Group 83 invention is inconsistent with prior Office Actions and the Examiner's definitions because claim 236 does not require reviving a dead portion of an organ. Thus, Applicant believes that the Examiner's holding of non-responsiveness is clearly erroneous and should be withdrawn.

An action on the merits of claims 254, 255, 236, 238, and 243-253 is respectfully requested in view of the above remarks.

Should the Examiner have any questions or require additional information or discussion to place the application in condition for allowance, a phone call to the undersigned attorney would be appreciated.

Respectfully submitted,

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